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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,840	02/28/2002	Cary Fitzgerald	2705-184	4505

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EXAMINER

JEAN GILLES, JUDE

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,840

Applicant(s)

FITZGERALD, CARY

Examiner

Jude J. Jean-Gilles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-11, 13-19, 23, 27-33, 37-39, 41-47, 51, 55 and 56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-11, 13-19, 23, 27-33, 37-39, 41-47, 51, 55 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Action is in regards to the Reply received on 02/07/2006.

Response to Amendment

1. This action is responsive to the application filed on 02/07/2006. Claims 1-56 were rejected in the First Office Action. Claims 6-8, 20-22, 34-36, and 48-50 are canceled. Claims 1-5, 9-11, 13-19, 23-25, 27-33, 37-39, 41-47, 51-53, and 55-56 are amended. Claims 12, 26, 40, and 54 remain in their original form. No new matter is present. Claims 1-5, 9-19, 23-33, 37-47, and 51-56 remain in the case for reconsideration. Reconsideration of the claims as requested, has been granted in light of the remarks as the claims are not in condition for allowance as presented. Claims 1-5, 9-19, 23-33, 37-47, and 51-56 represent "devices, software and methods for enabling SIP devices to operate in H.323 networks and H.323 devices to operate in SIP networks."

Response to Arguments

2. Applicant's arguments with respect to claims 1-5, 9-11, 13-19, 23-25, 27-33, 37-39, 41-47, 51-53, and 55-56 have been carefully considered, but are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new ground of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., a method wherein a processor is adapted to perform any conversions between protocols as taught in the claimed invention) to the claims which significantly affected the scope thereof.

The dependent claims stand rejected as articulated in the First Office Action and all objections not addressed in Applicant's response are herein reiterated.

In response to Applicant's arguments, 37 CFR § 1.11(c) requires applicant to "clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must show the amendments avoid such references or objections."

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 9-11, 13-19, 23-6, 27-33, 37-39, 41-47, 51-3, and 55-56 are

rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal et al

(Agrawal), U.S. Patent No. 6,788,660 B1 in view of Osterhout et al (Osterhout),

U.S. Patent No. 6,965,614 B1.

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Regarding claim 1, Agrawal discloses the invention as claimed. Agrawal teaches a device (*fig. 1, item 120; fig. 2, items 210-220; and fig. 6, item 330-1*) comprising:

a network interface for coupling to a network (*fig. 1, items 100, and 103*) using a first signaling protocol; and

a processor coupled with the network interface (*fig. 6, items 330-1, and 626; column 5, lines 19-36*), in which the processor is adapted to

receive and analyze a message (*column 5, lines 54-67; column 6, lines 1-28*) using a second signaling protocol (*fig. 2, items 200-5, and 200-11; column 4, lines 44-63; column 5, lines 37-67; column 6, items 1-28*).

However, Agrawal does not disclose convert the message received in the second signaling protocol to a message in the first signaling protocol; and transmit the message in the first signaling protocol to a network gatekeeper.

In the same field of endeavor, Osterhout discloses a network method and apparatus that allow "...communications session is established between the first device and the system over a network. The system converts between data according to the first protocol and data according to a second protocol defining a peripheral link from the system to the peripheral device..." [see Osterhout, column 2, lines 40-67].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Osterhout's teachings of convert the message received in the second signaling protocol to a message in the first signaling protocol; and transmit the message in the first signaling protocol to a

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network gatekeeper, with the teachings of Agrawal, for the purpose of "*converting data between different protocols in communications between the different types of devices...*" as stated by Osterhout in lines 13-15 of column 1. By this rationale **claim 1** is rejected.

Regarding independent claims 29, and 38, the limitations of the claims are taught within the figures disclosed in the combination Agrawal -Osterhout (e.g., see exemplary independent claim 1). Independent claims 29 and 38 teach the same network device that was examined in claim 1 and additionally, disclose a storage medium having instructions executed by at least one device [see Agrawal, fig. 6, items 330-1, 625, 628, and 630; see Osterhout, column 2, lines 14-40; column 3, lines 17-65; fig. 1].

Regarding independent claims 43, and 52, the limitations of the claims are taught within the figures disclosed in the combination Agrawal -Osterhout (e.g., see exemplary independent claim 1). Independent claims 43 and 52 teach the same network device that was examined in claim 1 in a method format instead of an apparatus format.

Regarding **claim 2**, the combination Agrawal -Osterhout teaches the device of claim 1, wherein

the first signaling protocol comprises a H.323 protocol,

the second signaling protocol comprises Session Initiation Protocol (SIP),

the message received in the second signaling protocol signaling protocol comprises a SIP invite message to initiate communications with a network device associated with the gatekeeper, and

the message in the first signaling protocol comprises an H.323 irequest message [see Agrawal; *column 4, lines 44-63; column 5, lines 37-67; column 6, items 1-28*; see Osterhout, column 2, lines 14-40; column 3, lines 17-65; fig. 1].

Regarding **claim 3**, the combination Agrawal -Osterhout teaches the device of claim 1, wherein

the first signaling protocol comprises a SIP,

the second signaling protocol comprises H.323 protocol,

the message received in the second signaling protocol signaling protocol comprises an H.323 request message to initiate communications with a network device associated with the gatekeeper, and

the message in the first signaling protocol comprises a SIP invite message [see Agrawal; *column 4, lines 44-63; column 5, lines 37-67; column 6, items 1-28*; see Osterhout, column 2, lines 14-40; column 3, lines 17-65; fig. 1].

Regarding **claim 4**, the combination Agrawal -Osterhout teaches the device of claim 1, in which the processor is further adapted to:

receive a response message in the first signaling protocol responsive to the message transmitted in the first signaling protocol to the network gatekeeper[see *Thomas, column 4, lines 64-67; column 5, lines 1-60*]:

decode from the response message a primary network address

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corresponding to a primary network device associated with the gatekeeper;
and

convert the response message received in the first signaling protocol to a reply message to a second signaling protocol; and

send the reply message of the second signaling protocol that contains the primary network address [see Agrawal; *column 4, lines 44-63; column 5, lines 37-67; column 6, items 1-28*; see Osterhout, column 2, lines 14-40; column 3, lines 17-65; fig. 1].

Regarding **claim 5**, the combination Agrawal -Osterhout teaches the device of claim 4, in which

the message received in the second signaling protocol is received from a first device, and the reply message to the message received from the first device is sent to a second device different from the first device [see Agrawal; *column 4, lines 44-63; column 5, lines 37-67; column 6, items 1-28*; see Osterhout, column 2, lines 14-40; column 3, lines 17-65; fig. 1].

Regarding **claim 9**, the combination Agrawal -Osterhout teaches the device of claim 4, in which the processor is further adapted to:

decode from the response message also an alternate network address corresponding to an alternate network device associated with the gatekeeper,
and

in which the reply message further contains the alternate network address [see Agrawal; *column 4, lines 44-63; column 5, lines 37-67; column 6, items 1-28*; see Osterhout, column 2, lines 14-40; column 3, lines 17-65; fig. 1].

Regarding independent claims 10, 15, and 24, the limitations of the claims are taught within the figures disclosed in the combination Agrawal -Osterhout (e.g., see exemplary independent claim 1). Independent claims 10, 15, and 24 teach the same network device that was examined in claim 1 [see Agrawal; *column 4, lines 44-63; column 5, lines 37-67; column 6, items 1-28*; see Osterhout, column 2, lines 14-40; column 3, lines 17-65; fig. 1].

Regarding independent claim 11, the combination Agrawal -Osterhout teaches the device the method of claim 10, in which

the H.323 request message is an Abstract Syntax Notation One (ASN.1) encoded Registration, Admission, Status (RAS) Location Request (LRQ) message [see Agrawal; *column 4, lines 44-63; column 5, lines 37-67; column 6, items 1-28*; see Osterhout, column 2, lines 14-40; column 3, lines 17-65; fig. 1].].

Regarding independent claim 12, the combination Agrawal -Osterhout teaches the device the method of claim 10, in which

The gatekeeper is preconfigured, and

The SIP location request message is transmitted over User Datagram Protocol (UDP) socket[see Agrawal; *column 4, lines 44-63; column 5, lines 37-67; column 6, items 1-28*; see Osterhout, column 2, lines 14-40; column 3, lines 17-65; fig. 1].

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Regarding independent claims 16, 25, 30, 39, 44, and 53 are substantially the same as **claim 2**, and is thus rejected for reasons similar to those in rejecting **claim 2**.

Regarding independent claims 12, 17, 26, 31, 40, 45 and 54 are substantially the same as **claim 3**, and is thus rejected for reasons similar to those in rejecting **claim 3**.

Regarding independent claims 13, 18, 27, 29, 32, 38, 41, 43, 46, and 55 are substantially the same as **claim 4**, and is thus rejected for reasons similar to those in rejecting **claim 4**.

Regarding independent claims 19, 33, and 47 are substantially the same as **claim 5**, and is thus rejected for reasons similar to those in rejecting **claim 5**.

Regarding independent claims 14, 23, 28, 37, 42, 51 and 56 are substantially the same as **claim 9**, and is thus rejected for reasons similar to those in rejecting **claim 9**.

Regarding independent claims 25, 39, and 53 are substantially the same as **claim 11**, and is thus rejected for reasons similar to those in rejecting **claim 11**.

Regarding independent claims 26, 40, and 54 are substantially the same as **claim 12**, and is thus rejected for reasons similar to those in rejecting **claim 12**.

REFERENCE CITED

6. Agrawal et al (Agrawal), U.S. Patent No. 6,788,660 B1;
Thomas et al (Osterhout), U.S. Patent No. 6,965,614 B1; and
Agrawal et al (Agrawal), U.S. Patent No. 7,002,989 B2. Note that this prior art reference teaches all the limitations taught by Osterhout in the rejection above. Applicant is advised to kindly consider this reference when responding to the current Office Action.

Response to Arguments

7. Applicant's Request for Reconsideration filed on 02/07/2006 has been carefully considered but is not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main point of contention which is that Agrawal and Thomas do not perform any conversions between protocols as taught in the claimed invention. It is the position of the Examiner that Agrawal and Thomas in combination teach the limitations of the claims although not in details. However, in view of Applicant's Remarks and amendment to the claims, new references of Agrawal and Osterhout in combination disclose all the limitations of the claimed invention in details as explained in the rejection above

Examiner notes with delight that no new matter has been added and that the new claims are supported by the application as filed. However, applicant has failed in presenting claims and drawings that delineate the contours of this invention as

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compared to the cited prior art. Applicant has failed to clearly point out patentable novelty in view of the state of the art disclosed by the references cited the 103(a) rejections applied against the claims, the rejection is therefore sustained.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-9000.

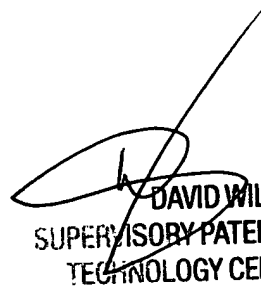
Jude Jean-Gilles

Patent Examiner

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JJG 

April 26, 2006


DAVID WILEY
SUPERVISORY PATENT EXAMINER
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